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EXAMINER

SING, SIMON P

ART UNIT PAPER NUMBER

2645

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/314,966

Applicant(s)

ALI ET AL.

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1.1 Claim 3 recites the limitation "said calling party" in line 4. There is insufficient antecedent basis for this limitation in the claim.

- 1.2 Claim 15 recites the limitation "said calling party" in line 5. There is insufficient antecedent basis for this limitation in the claim.

- 1.3 Claim 22 recites the limitation "said calling party" in line 5. There is insufficient antecedent basis for this limitation in the claim.

- 1.4 Claim 23 recites the limitation "said voice messaging system" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5, 7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Moganti US Patent No. 6,229,878.

2.1 Regarding claim 1, Moganti discloses a telephone answering device 100 (column 2, lines 36-40) in figures 1 and 2. Moganti's device comprises:

- a telephone line interface 206;

- a controller 202;

- voice message memory 210 (column 4, lines 3-11) adapted to store a plurality of voice messages;

- a secured message authorization module [software] (column 3, lines 40-43) to allow a party calling said telephone answering device to separately secure (segregated) in a single mail box a voice message (column 3, lines 29-34; column 4, lines 18-24) for

access only by a user authorized to play back said voice message by entering a security code (column 4, lines 50-55). Inherently, messages stored in Moganti's device are secured since a user needs password to access his computer [telephone answering device].

2.2 Regarding claim 2, the telephone answering device according to claim 1, further comprising a playback/recorder module [sound card 208 and storage device 210] adapted to record said voice message

2.3 Regarding claim 3, the telephone answering device according to claim 1, further comprising an authorized security code table including information relating to an ability of said calling party to separately secure said voice message (column 3, lines 29-34,40-43).

2.4 Regarding claim 4, the telephone answering device according to claim 3, wherein said authorized security code table further includes at least one security code allowing at least one user access to said separately secured voice message (column 4, lines 45-55).

2.5 Regarding claim 5, the telephone answering device according to claim 3, wherein said authorized security code table is adapted to include call related information relating

to at least one calling party authorized to secure a voice message (column 3, lines 29-34, 40-43; column 4, lines 22-24).

2.6 Regarding claim 7, the telephone answering device according to claim 1, wherein said message authorization module is adapted to allow said calling party to secure a voice message upon matching of call related information relating to said calling party to at least one pre-stored entry of call related information regarding an ability to secure a voice message (column 3, lines 29-34; column 4, lines 22-24).

2.7 Regarding claim 9, the telephone answering device according to claim 1, further comprising a call related information detector/receiver adapted to detect and receive call related information regarding said calling party (column 2, line 65 to column 3, line 6).

2.8 Regarding claim 10, the telephone answering device according to claim 1, wherein said controller is adapted to compare call related information received regarding said calling party with at least one pre-stored authorized security code to allow said calling party to separately secure said voice message (column 3, lines 40-43; column 4, lines 22-24).

3. Claims 1-7 and 9-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Nabkel US Patent No. 5,963,626.

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3.1 Regarding claim 1, Nabkel discloses a single mailbox voice messaging system, which can be a customer premises equipment (CPE) (column 4, lines 55-60), and a CPE with answering and recording functions is a telephone answering device. Nabkel's system comprising:

a telephone line interface for accepting telephone calls from callers (column 2, lines 28-30; column 4, lines 23-26; column 5, lines 61-65);

a controller for comparing user IDs and PINs (column 2, lines 30-37; column 4, lines 27-33);

a secured message authorization module adapted to allow a party [subscriber] calling said CPE to separately secure a voice message for access by an authorized user [a calling party who uses the CPE to retrieve a secured voice message] (column 2, lines 58-65; column 3, lines 53-58, column 4, lines 41-47).

3.2 Regarding claim 2, Nabkel's system further comprising:

a playback/recording module adapted to record said voice message (column 3, lines 16-26).

3.3 Regarding claim 3, Nabkel' system according claim 1, further comprising:

an authorized security code table including information relating to an ability of a calling party [subscriber] to separately secure said voice message (column 2, lines 28-36, 41-49, 58-65; column 3, lines 53-58).

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3.4 Regarding claim 4, Nabkel's system according to claim 3, wherein:

said authorized security code table further includes at least one security code (PIN) allowing at least one user [calling party] access to said separately secured voice message (column 2, lines 58-65; column 3, lines 53-58; column 4, lines 41-47).

3.5 Regarding claim 5, Nabkel's system according to claim 3, wherein:

said authorized security code table is adapted to includes call related information (PIN) relating to at least one calling party [subscriber] authorized to secure a voice message (column 2, lines 28-36, 58-65; column 3, lines 53-58).

3.6 Regarding claim 6, Nabkel's system according claim 1, wherein:

said secured message authorization module is adapted to allow said calling party [subscriber] to secure a voice message upon entry of an authorized security code by said calling party (column 2, lines 58-65; column 3, lines 53-58).

3.7 Regarding claim 7, Nabkel's system according claim 1, wherein:

said secured message authorized module is adapted to allow said calling party [subscriber] to secure a voice message upon matching call related information (PIN) relating to said calling party [subscriber] to at least one pre-stored entry of call related information regarding an ability to secure a voice message (column 2, lines 28-36).

3.8 Regarding claim 9, Nabkel's system according claim 1, further comprising:

a call related information detector/receiver adapted to detect and receive call related information (PIN) regarding said calling party [subscriber] (column 2, lines 28-36).

3.9 Regarding claim 10, Nabkel's system according claim 1, wherein:

said controller is adapted to compare call related information received regarding said calling party [subscriber] with at least one pre-stored authorized security code to allow said calling party [subscriber] to separately secure said voice message (column 2, lines 28-36, 58-65; column 3, lines 53-58).

3.10 Regarding claim 11, Nabkel discloses a single mailbox voice messaging system, which can be a customer premises equipment (CPE) (column 4, lines 55-60), and a CPE with answering and recording functions is a telephone answering device. Nabkel's method for securing a voice message, comprising:

prompting a party [subscriber] to enter an authorized security code (column 2, lines 28-30);

comparing an entered authorized security code to at least one pre-stored authorized security code accessible by said CPE (column 2, lines 30-37); and

upon matching said entered authorized security code with at least one pre-stored authorized security code, securing in a single mailbox a recorded message (column 2, lines 58-65; column 3, lines 53-58) for access only by a user [a calling party who uses

the CPE to retrieve a secured voice message] authorized to play back said voice message (column 4, lines 41-47).

3.11 Regarding claim 12, Nabkel's method for securing a voice message according to claim 11, where in:

said securing is performed after said message is being recorded (column 3, lines 53-58, figure 3).

3.12 Regarding claims 13 and 14, Nabkel teaches a method for securing a voice message on a voice messaging system according to claim 11, where in:

said securing is performed before and while said message is being recorded (column 2, lines 58-65).

3.13 Regarding claim 15, Nabkel teaches that a calling party [subscriber] is prompted to enter his PIN (column 2, lines 28-30), Nabkel also teaches interfacing with DTMF via a telephone (column 5, lines 61-65).

3.14 Regarding claim 16, Nabkel discloses a single mailbox voice messaging system, which can be a customer premises equipment (CPE) (column 4, lines 55-60), and a CPE with answering and recording functions is a telephone answering device. Nabkel's method comprising:

prompting a user [a calling party who uses the CPE to retrieve a secured voice message] to enter a PIN [security code] on a voice message-by-voice message basis for secure voice messages (column 4, lines 41-47, 50-52; figure 5, steps 162-170);

comparing an entered PIN to at least one pre-stored PIN accessible by said CPE (column 4, lines 41-47); and

upon matching said entered PIN with said at least one pre-stored PIN, allowing said user [calling party] access to an underlying voice message secured in a single mailbox of said CPE (column 4, lines 41-47).

3.15 Regarding claim 17, Nabkel teaches entering a PIN [security code] for each secured voice message (column 4, lines 50-52; figure 5, steps 162-170).

3.16 Regarding claim 18, Nabkel discloses a single mailbox voice messaging system, which can be a customer premises equipment (CPE) (column 4, lines 55-60), and a CPE with answering and recording functions is a telephone answering device. Nabkel's system comprising:

means for prompting a party [subscriber] calling said CPE to enter an authorized PIN [security code] (column 2, lines 28-30);

means for comparing an entered authorized PIN to at least one pre-stored authorized PIN accessible by said CPE (column 2, lines 30-37); and

means for securing in a single mailbox of said CPE a recorded voice message (column 2, lines 58-65; column 3, lines 53-58) for access only by a user [a calling party

who uses the CPE to retrieve a secured voice message] authorized to play back said voice message (column 4, lines 41-47), upon matching said entered authorized PIN with at least one pre-stored authorized PIN (column 2, lines 30-36).

3.17 Regarding claim 19, Nabkel's system according to claim 18, wherein:

said means for securing secures said voice message after it is being recorded (column 3, lines 53-58, figure 3).

3.18 Regarding claim s 20 and 21, Nabkel's system according to claim 18, wherein:

said means for securing secures said voice message before and while it is being recorded (column 3, lines 53-58, figure 3).

3.19 Regarding claim 22, Nabkel's system includes means for entering said security code from a calling party's [subscriber] telephone (column 2, lines 28-30; column 5, lines 61-65).

3.20 Regarding claim 23, Nabkel discloses a single mailbox voice messaging system, which can be a customer premises equipment (CPE) (column 4, lines 55-60), and a CPE with answering and recording functions is a telephone answering device. Nabkel's system comprising:

means for prompting a user [a calling party who uses the CPE to retrieve a secured voice message] to enter a PIN [security code] on voice message-by-voice message basis (column 4, lines 50-52; figure 5, steps 162-170);

means for comparing the entered PIN to at least one pre-stored PIN accessible by said CPE (column 4, lines 41-47); and

means for allowing said user access to an underlying voice message secured in a single mailbox , upon matching said entered PIN with at least one pre-stored PIN (column 4, lines 41-47);

3.21 Regarding claim 24, the Nabkel system according to claim 23, further comprising:

means for entering a PIN [security code] for each secured voice message (column 4, lines 50-52; figure 5, steps 162-170).

4. Claim 1, 2, 7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Ali et al. US Patent 6,335,962.

4.1 Regarding claim 1, Ali discloses a voice messaging system in figure 1. Ali's system comprises:

a telephone line interface 48;

a controller 18;

voice message memory (column 4, lines 4-7) adapted to store play a plurality of voice messages by a voice record/playback module 20;

a regrouping module 17 and a user input grouping directory 16b [message authorization module] adapted to authorize a calling party to separately secure a voice message in an individual mailbox (column 7, lines 15-20).

4.2 Regarding claim 2, Ali discloses a playback/record module 20 to record a voice message.

4.3 Regarding claim 7, Ali teaches that the regrouping module 17 and regrouping directory 16b, is adapted to allow said calling party to secure a voice message upon matching of called related information relating to said calling party to at least one pre-stored entry of called related information regarding an ability to secure a voice message (column 5, lines 44-47).

4.4 Regarding claim 9, Ali discloses a call information detector/receiver module 12 to detect and receive call related information (column 3, lines 49-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nabkel US Patent No. 5,963,626 in view of Johanson et al. US Patent No. 6,215,860.

Nabkel discloses CPE in that a first calling party (column 2, lines 28-32) can leave voice message with specified security parameters (column 3, lines 53-55) to second calling party (column 4, lines 41-47). Nabkel fail to teach that the voice message includes a header containing a secure status of said voice message.

In addition, Johanson discloses a digital telephone answering machine (column 3, lines 60-61). Johanson teaches that a voice message includes user defined header information [TAG] (column 2, lines 13-20).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Nabkel's reference with the teaching of Johanson, so that the security parameters of a voice messages would have been stored in the header portion of said voice message in the memory, because such a modification would have clarified the Nabkel's teaching of how the security parameters was attached to a voice message.

6. Claims 11-15 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moganti US Patent No. 6,229,878 in view of Lee US Patent No. 5,604,791.

6.1 Regarding claim 11, Moganti discloses a telephone answering device 100 (column 2, lines 36-40) with a single mailbox in figures 1 and 2. Moganti's method of secure a voice message comprising:

comparing a calling party's caller ID or other data retrieved from the telephone line connected to the telephone answering device (column 3, lines 29-34, 40-43; column 4, lines 18-24);

securing voice messages from selected calling parties (column 3, lines 32-34; column 4, lines 22-24). Inherently, messages stored in Moganti's device are secured since a user needs password to access his computer [telephone answering device]; and

allowing an authorized user to access and play back said voice message by entering a security code (column 4, lines 50-55).

Moganti teaches retrieving other data from the telephone line and comparing such data to allow a predetermined caller to secure voice message as discussed above, but fails to teach prompting a calling party to enter a security code.

However, Lee discloses a telephone answering device (column 10, lines 57-59), which prompts a calling party to enter his telephone number via a telephone keypad (column 11, lines 3-10; column 12, lines 53-58) and compare the entered telephone number (column 13, lines 13-20) to handle the incoming call accordingly (column 13, lines 59-67; column 14, lines 8-12, 21-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Moganti's reference with the teaching of Lee, so that telephone answering device would have prompted a calling party to enter a

security code, which could be a telephone number, because such a modification would have clarified Moganti's teaching of other data on a telephone line, and would have enabled a calling party to secure a voice message from a payphone.

6.2 Regarding claims 12-14, as discussed in claim 11, a voice message left in the telephone answering device of the modified Moganti reference is secured.

6.3 Regarding claim 15, as discussed in claim 11, the Moganti reference, modified by Lee, teaches entering said security code from a telephone being used by a calling party.

6.4 Regarding claim 18, Moganti discloses a telephone answering device 100 (column 2, lines 36-40) with a single mailbox in figures 1 and 2. Moganti's system comprising:

means for comparing a calling party's caller ID or other data retrieved from the telephone line connected to the telephone answering device (column 3, lines 29-34, 40-43; column 4, lines 18-24);

means for securing voice messages from selected calling parties (column 3, lines 32-34; column 4, lines 22-24). Inherently, messages stored in Moganti's device are secured since a user needs password to access his computer [telephone answering device]; and

means for allowing an authorized user to access and play back said voice message by entering a security code (column 4, lines 50-55).

Moganti teaches retrieving other data from the telephone line and comparing such data to allow a predetermined caller to secure voice message as discussed above, but fails to teach prompting a calling party to enter a security code.

However, Lee discloses a telephone answering device (column 10, lines 57-59), which has means for prompting a calling party to enter his telephone number via a telephone keypad (column 11, lines 3-10; column 12, lines 53-58) and compare the entered telephone number (column 13, lines 13-20) to handle the incoming call accordingly (column 13, lines 59-67; column 14, lines 8-12, 21-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Moganti's reference with the teaching of Lee, so that telephone answering device would have had means for prompting a calling party to enter a security code, which could be a telephone number, because such a modification would have clarified Moganti's teaching of other data on a telephone line, and would have enabled a calling party to secure a voice message from a payphone.

6.5 Regarding claims 19-21, as discussed in claim 18, a voice message left in the telephone answering device of the modified Moganti reference is secured.

6.6 Regarding claim 22, as discussed in claim 18, the Moganti reference, modified by Lee, teaches entering said security code from a telephone being used by a calling party.

Response to Amendment

7. It is noted that the amendment, filed on 7/18/2002, claims priority of Ali et al. US Patent No. 6,335,962 (hereafter referred to as Patent 962). However, examiner does not believe that the current application is entitled for the priority date of Patent 962, because the declaration of the application filed on 5/20/1999 fails to claim domestic priority. Further, the current application and Patent 962 are two separate entities with one common inventor. It is unclear which inventive feature was invented by the common inventor. In addition, Patent 962 teaches grouping voice messages in multiple mailboxes (column 7, lines 15-20), and does not teach securing voice messages in one single mailbox. Patent 962 also does not teach using a security code on a voice-message to voice-message basis. In conclusion the specification of current application is different from the specification of Patent 962, and the priority claim is rejected.

Response to Arguments

8. Applicants' arguments filed 7/18/2002 have been fully considered but they are not persuasive.

The applicants argue on pages 14 and 15 of the Remark that the Nabkel reference fails to disclose or suggest a TAD that allowed a party calling the TAD secures access to voice messages by the TAD's user on a voice-message by voice-message basis.

Nabkel system not only can be implemented using a network, or adjunct to a communication station, but can also be implemented on a Customer Premises Equipment (CPE) (column 4, lines 55-60). An implemented CPE which answers and records incoming telephone calls is definitely a telephone answering device (TAD).

Nabkel also states that a party calling the CPE (figure 1, steps 110-114; column 2, lines 28-36; column 3, lines 16-26) can secure a voice message for a user (anyone using a CPE to leave or retrieve voice messages is a user of the CPE) (column 3, lines 53-58), and the user retrieves voice messages on a voice-message to voice-message basis (column 4, lines 50-52; figure 5, steps 162-170).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

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S.S.

10/02/2002

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over the printed name.